

## **Remarks**

### **Introduction**

Reconsideration of the present application as amended and in view of the remarks below is respectfully requested. Claims 1-35 are currently pending. Claims 1, 13, 14, 17, 25, 26, 28 and 35 have been amended. Upon entry of the above amendments, claims 1-35 will be pending in this application.

### **Non-Statutory Double Patenting**

Claims 1-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7 and 18 of U.S. Patent No. 6,738,810.

A terminal disclaimer is filed with this response. Applicants do not acquiesce to the Examiner's rejection, but in an effort to expedite prosecution, have chosen to file the terminal disclaimer.

### **Specification Objected to**

The abstract of the disclosure has been objected to because of a typographical error made in the last sentence where one or more words are missing or mistyped. In response to this rejection, the abstract been amended to correct the noted errors. No new matter is believed to be added by these amendments. The Examiner's approval is respectfully requested.

### **Claim Rejections – 35 U.S.C. § 103**

#### **Norris et al. U.S. Patent No. 5,510,780**

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris et al. (US 5,510,780) in view of Official Notice.

With regard to the rejection under 35 U.S.C. §103, Applicants submit that the Norris in view of the Examiner's Official Notice does not support the Examiner's rejection of the present claims under 35 U.S.C. §103(a).

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. Section 103(a); see Graham v. John Deere Co., 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). "The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on

underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.” In re Dembiczak, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all the claim limitations. M.P.E.P. § 2143. Moreover, to establish a *prima facie* case of obviousness, the Examiner must also demonstrate that there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue. See *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (Slip Op. at 14.) (550 U.S. \_\_\_, (April 30, 2007). Even if each feature of a claim can be independently shown within the cited art references, this alone is insufficient to conclude that a claim is obvious in view of such art. *Id.* Instead, to render a claim obvious over a combination of cited references, an Examiner must provide “some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” *Id.* In addition, establishing that a claimed combination is not a “predictable use of prior art elements according to their established functions” may be used to demonstrate nonobviousness. *Id.* at 13. In other words, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 15. Moreover, the Examiner must make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge possessed by a person having ordinary skill in the art.” *Id.* at 14. Essentially, the Examiner cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention to support an obvious rejection; rather, the Examiner has the burden to show some apparent reason or justification to combine the known elements in the fashion claimed by the patent at issue. See *Id.* and *Smith-Kline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988).

Norris et al. describes a security code activation control system for controlling the operation of equipment which is leased or sold and more particularly to such a system which is self-contained (emphasis supplied) and in which a combination security code is

automatically changed with each billing cycle.(See column 1, lines 7-12) These periodic code changes should be automatic, requiring no personnel from the lessor or seller to have access to the equipment, and requiring no telephone or other communications link between the lessor or seller and the equipment.(column 2, lines 26-30)

A time cycled security code activation system for leased or time purchased equipment includes a code input device such as a numeric keypad. The keypad is connected to a microcontroller, which may be a microprocessor and peripherals, which controls an activation relay which selectively supplies power to the equipment. The microprocessor is connected to a memory in which is stored a series of activation codes, for example 36 codes, including a currently valid code. The microprocessor is also connected to a real time clock circuit and the microprocessor includes a clock counter for monitoring lease or installment sale period. The microprocessor is programmed to compare the current time, as stored in the clock counter, with an expiration time of a lease or installment purchase period.(column 2, lines 33-47) When the equipment to be sold or leased is delivered to the customer, the seller or lessor powers up the microprocessor. The microprocessor scans the keypad for an initialization code which is input by the seller or lessor. The initialization code is compared against a valid stored code and the relay is enabled, closing the relay contacts and thus connecting the equipment to a power source while the microprocessor operating program is begun.(column 5, lines 25-34)

Consequently, it can be seen that Norris describes a security code activation control system which is self-contained and which is coupled to equipment which is either leased or sold. The system includes a memory in which is stored a series of activation codes, including a currently valid code. An activation code is input through the keypad to enable the equipment to be operated.

The Examiner has also taken Official Notice that remote communications are well known at the time of Applicants' invention. Also the Examiner states that Norris does not explicitly disclose a database and shut-off values and current values used in determining periodic shutoff or continued enablement decisions relating to a customer's performance against a payment schedule or the sending of warning messages to the customer payer. The Examiner however states that one or more databases and warning messages are implicit in Norris teaching.(See Office Action, page 4, line 9-20)

Neither Norris or the Examiner's Official Notice, either alone or in combination, describes Applicants' invention of claim 1 as amended. Claim 1 recites a method of encouraging payments associated with a computer system. The method includes the steps of

providing to the computer system current customer information from a database, the database including information identifying a plurality of customers, each of the customers having a shutoff value, the current customer information including one of the shutoff values. The method further includes the steps of comparing the one of the shutoff values from the current customer information and a current value of the computer system and enabling use of the computer system if the current value of the computer system is less than the one of the shutoff values.

Norris does not disclose a computer system having a database including an information system identifying a plurality of customers wherein each of the customers has a shutoff value. Norris also does not disclose having a current customer information including a shutoff value which is compared to one of the shutoff values which is stored in the database to a current value of the computer system.

Applicants believe that the Examiner has failed to make a *prima facie* case of obviousness. The Examiner has failed to provide a motivation for providing the proposed elements and has failed to produce authority showing that such a combination is suggested. As the Federal Circuit has noted, “evidence of a suggestion, teaching, or motivation to combine may flow from [many sources]... The range of sources available however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone are not ‘evidence.’” In re Dembiczak, 175 F.3d 991, 999 (Fed. Cir. 1999).

Furthermore, as stated in *KSR International Co. v. Teleflex Inc.* above, to establish a *prima facie* case of obviousness, the Examiner must demonstrate that there is an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Examiner has not provided any rationale for the proposed combination but has only recited claim elements and stated that such claim elements are “implicit” in Norris. Applicants disagree with this reasoning, since Norris does not describe a device which would suggest or imply any of the elements which Examiner states are “implicit”.

Norris describes a self-contained device which is attached to equipment delivered to a customer. Norris does not describe or even suggest providing information from a database including information identifying a plurality of customers, each of the customers having a shutoff value. In fact, Norris teaches away from such a step because the article being leased or sold is delivered to one lessee or customer at a time.

For at least these reasons, removal of the rejection and allowance of claim 1 is respectfully requested. If the Examiner should disagree with the Applicants’ arguments, the

Examiner is asked to kindly point out with particularity where Applicants' claimed invention is disclosed, suggested, or taught.

Claims 2-12 depend from claim 1 and contain additional limitations that define over the cited art. Furthermore since claim 1 is believed to be allowable, claims 2-12 are also believed to be allowable. Removal of the rejections and allowance of claims 2-12 is respectfully requested.

### **Claim 13**

Claim 13 has been rejected under 35 U.S.C. §103(a). Claim 13 as amended recites a computer readable medium for encouraging payments associated with a computer system, the computer readable medium including a plurality of instructions which when executed by the computer system cause the computer system to compare a retrieved shutoff value from a database including information identifying a plurality of customers, each of the customers having a shutoff value, and a current value of the computer system wherein the retrieved shutoff value is based upon a credit associated with the computer system and the current value is based upon a system clock of the computer system; and enable use of the computer system based upon determining that the retrieved shutoff value is greater than the current value.

For the reasons stated above and in view of the fact that Norris does not either explicitly or implicitly describe Applicants' claimed invention, Applicants believe that claim 13 is allowable. Removal of the rejection and allowance of claim 13 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where Applicants' claimed invention is disclosed, suggested, or taught.

Claims 14-16 depend from claim 1 and contain additional limitations that define over the cited art. Furthermore since claim 13 is believed to be allowable, claims 14-16 are also believed to be allowable. Removal of the rejections and allowance of claims 14-16 is respectfully requested.

### **Claim 17**

Claim 17 has been rejected under 35 U.S.C. §103(a). Claim 17 as amended recites a method of establishing a usage period associated with a computer system for a user. The method includes the steps of retrieving a first shutoff value from one of a plurality of shutoff values stored in a database, the database having a plurality of users, wherein each of the users is associated with one of the plurality of shutoff values; notifying the user that a payment associated with the computer system is due by a first shutoff value; receiving a

second shutoff value; providing the second shutoff value to the computer system through a communication link; and enabling use of the computer system if a current value of the computer system is less than the second shutoff value.

For the reasons stated above and in view of the fact that Norris does not either explicitly or implicitly describe Applicants' claimed invention, Applicants believe that claim 17 is allowable. Removal of the rejection and allowance of claim 17 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where Applicants' claimed invention is disclosed, suggested, or taught.

Claims 18-24 depend from claim 17 and contain additional limitations that define over the cited art. Furthermore since claim 17 is believed to be allowable, claims 18-24 are also believed to be allowable. Removal of the rejections and allowance of claims 18-24 is respectfully requested.

#### **Claim 25**

Claim 25 has been rejected under 35 U.S.C. §103(a). Claim 25 as amended recites a method of encouraging payments associated with a computer system. The method includes the steps of providing to the computer system current customer information from a database, the database including information identifying a plurality of customers, each of the plurality of customers having a shutoff value, the current customer information including one of the shutoff values, which is based upon at least one credit associated with the computer system; comparing the one of the shutoff values to a current value of the computer system; and enabling use of the computer system based upon the comparison of the current value and the one of the shutoff values.

For the reasons stated above and in view of the fact that Norris does not either explicitly or implicitly describe Applicants' claimed invention, Applicants believe that claim 25 is allowable. Removal of the rejection and allowance of claim 25 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where Applicants' claimed invention is disclosed, suggested, or taught.

Claims 26-35 depend from claim 25 and contain additional limitations that define over the cited art. Furthermore since claim 25 is believed to be allowable, claims 26-35 are also believed to be allowable. Removal of the rejections and allowance of claims 18-24 is respectfully requested.

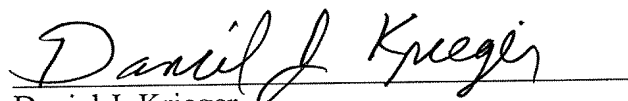
### **Final Remarks**

Applicants submit that claims 1-35 are in condition for allowance. In view of the foregoing, it is respectfully submitted that all of the solicited claims are in condition for allowance. Such action is respectfully requested.

Applicants have included an extension of time with this response. Applicants request that, if necessary, this response be considered a request for an extension of time to enable this response to be timely filed. Applicants request that any required fees for filing the response be charged to the account of Bose McKinney and Evans LLP, Deposit Account Number 02-3223. In the event that there are any questions related to these amendments or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

Respectfully submitted,

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